REMARKS

In the Office Action, the Examiner rejected claims 11-15 under 35 U.S.C. § 103 on the basis of Beffa (Great Britain 2,321,434) and claim 16 on a combination of Beffa with Doesburg (US 5,520,958). Independent claims 24 and 29 were also rejected under 35 U.S.C. § 103 on the combination of Beffa in view of Anderson (US 3,869,330) and D'Andrea et al. (US 3,257,258). Finally claims 25 and 30, dependent on claims 24 and 29, respectively, were further rejected under 35 U.S.C. § 103 in view of Pechmann (US 3,159,121).

By this Amendment, independent claims 11, 24, and 29 have been amended to positively recite the machinery employed for handling cartons and positioning them for labeling in a laminating station. This apparatus is shown in block form as element 82 in Fig. 2 and in the machine diagram as element 102 in Fig. 5, which operates in cooperation with the laminating press as described in paragraph 25 of the publication 2003/0144853 of the present application. Claim 24 positively recites the cartons 10 as well.

Initially, it is noted that the Beffa disclosure is one which appears to be devoid of any drawings showing or describing how the system operates and is merely a labeling method for applying labels to cylindrical objects, such as ball point pens, paintbrush, fountain pen, or a propelling pencil. In fact, on page 3 of the disclosure, it discloses that the labels are "applied by hand to the casings of the pens". Applicants' invention, on the other hand, is an automated, just-in-time labeling system employed for labeling cartons utilizing, in part, the production equipment discussed in paragraph 26 of the published version of the subject application. The result is a high

throughput labeling system which can accommodate immediate demands for labeled cartons for particular products which results in facilitating throughput at very high efficiencies.

In order to more clearly define Applicants' invention over the manual writing instrument labeling disclosure of the primary reference to Beffa, Applicants' have amended independent claims 11, 24, and 29 to define that the apparatus includes a carton feeding machine for positioning individual cartons for labeling, after which the laminating machine (claim 11) applies adhesive to the label and laminates it onto the carton in indexed relationship. Claim 24 adds to this combination the cartons themselves and a smoothing station and a stacking station for the subsequently labeled cartons. Claim 29 defines the machine as a high speed, digitally controlled apparatus for printing custom labels and laminating them onto cartons, including the carton feeding station for positioning the cartons for labeling by the laminating station. The meager disclosure of Beffa, including the hand applying of labels to writing instruments, would not suggest, in combination with the commercial equipment defined in Applicants' paragraph 26 or the remaining secondary references to Doesburg, Anderson, and D'Andrea, the high speed carton labeling apparatus now defined by claims 11-16, 24, 25, 29, and 30 of Applicants' invention.

The requirements for making a *prima facie* case of obviousness are described in MPEP § 2143 as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claims limitations.

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488,20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP § 2143.01 states under the heading "Fact That Reference Can Be Combined or Modified is not Sufficient to Establish *Prima Facie* Obviousness":

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

and under the heading "Fact That the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is not Sufficient by Itself to Establish *Prima Facie* Obviousness":

> A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made,' because the references relied upon teach all aspects of the claimed invention were individually known in the prior art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

There would be no logical reason to combine the manual label applying teaching of Beffa with the unnecessary and undoubtedly unworkable (in the Beffa environment) teachings of the secondary references apart from Applicants' teachings herein and such attempted hindsight reconstruction of the invention is impermissible. See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985) where the court noted:

> When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

As a result, it is submitted that Applicants' claims, as submitted herein, define patentable subject matter and are in condition for allowance, which action is respectfully solicited.

Respectfully submitted,

WILLIAM J. STEHOUWER ET AL.

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP

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Date

H. W. Reick
Registration No. 25 438
695 Kenmoor S.E.
P.O. Box 2567
Grand Rapids, MI 49501
Phone: (616) 949-9610
Facsimile: (616) 957-8196

HWR:dal